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09/917,722	07/31/2001	Kyoung Sup Shin	P-0247	1247
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FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			EXAMINER QUIETT, CARRAMAH J	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/917,722		SHIN, KYOUNG SUP	
	<b>Examiner</b>		<b>Art Unit</b>	
	Carramah J. Quiett		2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,7,10,13 and 16-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,10,13 and 16-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 and 28 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment(s), filed on 04/24/2006, have been entered and made of record. Claims 1-2, 7, 10, 13, and 16-42 are pending. Please note that Examiner has decided to grant Applicant a second Non-Final Office Action due to the Second Preliminary Amendment (filed 1/23/2006) and the Office Action (mailing date 1/25/2006) "crossing paths" in the mail.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 2, 7, 10, 13 and 16-42 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner has decided to use Hayashi et al. (U.S. Patent #6,618,082) in the place of Kuchta et al. (U.S. #5,164,831), which appears in the References Cited of the Hayashi patent. Therefore, claims 1-30 will be rejected using Hayashi et al. (U.S. Patent #6,618,082) in view of Szajewski et al. (U.S. #6,801,719).

With respect to Szajewski, the Applicant asserts that Szajewski does not disclose transmitting and displaying during telephonic communication. Once again, the Examiner respectfully disagrees. Szajewski teaches a method for transmitting and displaying, (inherently) during telephonic communication (col. 10, lines 6-46). The communication module (46) transmits the image signals via an optical network (such as a cellular network, a telecommunication network, etc.) to devices such as an Internet appliance, a personal digital assistant and a television. Devices such as these inherently have displays. It is well known in the art to utilize telephonic communication during Internet usage in order to view the image

being transmitted. Therefore, the image signal of Szajewski is transmitted and displayed during telephonic communication.

The Applicant also states that the Examiner appears to misunderstand the claimed invention because the Examiner cited references related to cameras and that the claimed invention is related to video conferencing. As requested by the Applicant, the Examiner called the Attorney, Fredrick D. Bailey, representing the Applicant on Friday, July 07, 2006 at around 11:00 am, in order to discuss the alleged misunderstanding. However, the Attorney was not available, so the Examiner provided a voicemail message. If the Examiner's response has not satisfied the Applicant's concerns, an interview (telephonic or personal) is encouraged. To schedule an interview, the Examiner's contact information appears toward the end of the present Office Action.

As far as video conferencing, video telephony, and video telephone call is concerned, the amendment to the specification and the claims is considered new matter. Therefore, the Applicants arguments regarding video conferencing, video telephone call, and/or video telephony are moot. Respectfully, the present application has not been misclassified. The disclosure does not give any indication that video conferencing, video telephony, and video telephone call is occurring. Instead, throughout the disclosure (for example see Specification, page 1 as well as figures 1-3) describes an image signal transmitting/ receiving apparatus such as a mobile/image communication terminal. The disclosed invention can be considered a camera (or an imaging device) with a telecommunication function (or device). Accordingly, the camera references cited by the Examiner are applicable to what has been claimed *and disclosed* by the

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Applicant. The claim rejection under 35 USC § 112, which appears on the next page, will explain how claims 1-42 will be examined.

Regarding independent claims 1, 7, 10, 13, 30, 31, 35, 39, and 40, Examiner respectfully disagrees with the Applicant submission. Independent claims 1, 7, 10, 13, 30, 31, 35, 39, and 40, are not recited as, “transmitting and displaying, during a video telephone call, a sub-image signal instead of the main image signal when the cut off mode is set, an image signal selector for outputting during a video telephone call a sub-image signal instead of the main image signal to the image signal processor when the cut off mode has been set, performing during a video telephone call one of transmitting a second image signal stored in a storage unit if the cut off mode has not been set or transmitting the encoded image signal inputted if the cut off mode has been set, or a telephone terminal that includes a controller operating to selectively transmit the first image signal of a prestored second image signal from the memory unit to a received side during a video telephone call based on a user’s setting.”

### ***Specification***

3. The amendment filed 04/24/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: video telephony, video telephone call and video conferencing (Amendments to the Specification, filing date 04/24/2006, page 2, lines 2-3).

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-2, 7, 10, 13, and 16-42** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7, 10, 13, 17, 19, 23, and 30 each have been amended to include “video telephone call”, which is new matter. For the prior art rejection, Examiner *will only* consider claims 1-30. However, “telephonic communication” will be examined in the place of “video telephone call”.

Also, claims 31, 32, 35-37, are 39-42 each include “video telephone call”, which is new matter. Therefore the newly added claims 31-42 will not be considered in the prior art rejection because they contain new matter.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 1-2, 7, 10, 13, and 16-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. (U.S. Patent #6,618,082) in view of Szajewski et al. (U.S. #6,801,719).

As for **claim 1**, Hayashi teaches an image signal transmitting/receiving method, in figure 1, comprising the steps of:

transmitting/receiving a main (original) image signal (col. 2, line 47 – col. 3, line 26);

As shown in fig. 1, image signals are transmitted from the first signal processing circuit (20) through a bus (22) and a CPU (28) to memories (24, 38, and 46), which receives and stores image signals. Please read col. 2, line 47 – col. 3, line 26.

determining whether a cut-off mode has been set for the main image signal (col. 3, line 62 – col. 4, line 29);

Hayashi teaches a reproducing mode involving a normal reproducing mode and a continuous reproduction mode. The original (main) image is displayed when the forward (or the reverse) feed button is depressed. A cut off mode is set for the main image signal when the operator depresses the feed button 2 or more seconds. A 4-bit micro-computer determines whether this cut off mode has been set. Also, please read col. 4, line 56 – col. 5, line 9.

transmitting and displaying a sub-image signal (thumbnail) instead of the main image signal in case that the cut-off mode is set (col. 4, lines 16-29).

Hayashi also teaches that the image signal is also transmitted to an output terminal (fig. 1, ref. 36). However, Hayashi does not expressly teach a method for transmitting and displaying during telephonic communication. In the same field of endeavor, Szajewski teaches a method

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for transmitting and displaying, during telephonic communication, a sub-image signal (fig. 1, ref. 46; col. 10, lines 6-52). In light of the teaching of Szajewski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hayashi with a means for transmitting and displaying, during telephonic communication in order to evaluate images for composing the image (col. 11, lines 8-21).

For **claim 2**, Hayashi further teaches a method wherein the main image signal is a received image signal (col. 2, line 47 – col. 3, line 26).

As shown in fig. 1, image signals are transmitted from the first signal processing circuit (20) through a bus (22) and a CPU (28) to memories (24, 38, and 46), which receives and stores image signals. Please read col. 2, line 47 – col. 3, line 26.

Regarding **claim 7**, Hayashi discloses an image signal transmitting/receiving apparatus, in fig. 1, comprising:

an image signal processor (ref. 30) for processing a main (original) image signal (col. 3, line 62 – col. 4, line 10);

a display unit (ref. 34) for displaying the received main image signal (col. 3, line 62 – col. 4, line 10);

a controller (ref. 42) for checking whether a cut-off mode has been set for the main image signal (col. 3, line 62 – col. 4, line 29); and

Hayashi teaches a reproducing mode involving a normal reproducing mode and a continuous reproduction mode. The original (main) image is displayed when the forward (or the reverse) feed button is depressed. A cut off mode is set for the main image signal when the operator depresses the feed button 2 or more seconds. A 4-bit micro-computer



determines whether this cut off mode has been set. Also, please read col. 4, line 56 – col. 5, line 9.

an image signal selector (ref. 48) for selectively outputting a sub-image signal instead of the main image signal to the image signal processor or\* the display unit in case that the cut-off mode has been set (col. 4, lines 16-29).

Hayashi also teaches that the image signal is also transmitted to an output terminal (fig. 1, ref. 36). However, Hayashi does not expressly teach an image signal selector for outputting during a telephonic communication. In the same field of endeavor, Szajewski teaches outputting, during a telephonic communication (fig. 1, ref. 46), a sub-image signal. In light of the teaching of Szajewski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Hayashi for outputting during a telephonic communication in order to evaluate images for composing the image (col. 11, lines 8-21).

For **claim 10**, Hayashi further discloses an image signal transmitting apparatus, in fig. 1, comprising:

an image signal processor (ref. 30) for processing a main (original) image signal (col. 3, line 62 – col. 4, line 10);

a controller (ref. 42) for checking whether a cut-off mode has been set for the main image signal (col. 3, line 62 – col. 4, line 29);

Hayashi teaches a reproducing mode involving a normal reproducing mode and a continuous reproduction mode. The original (main) image is displayed when the forward (or the reverse) feed button is depressed. A cut off mode is set for the main image signal when the operator depresses the feed button 2 or more seconds. A 4-bit micro-computer

determines whether this cut off mode has been set. Also, please read col. 4, line 56 – col. 5, line 9.

an image signal selector (ref. 48) for outputting a sub-image signal instead of the main image signal to the image signal processor in case that the cut-off mode has been set (col. 4, lines 16-29).

Hayashi also teaches that the image signal is also transmitted to an output terminal (fig. 1, ref. 36). However, Hayashi does not expressly teach an image signal selector for outputting during a telephonic communication. In the same field of endeavor, Szajewski teaches outputting, during a telephonic communication (fig. 1, ref. 46), a sub-image signal. In light of the teaching of Szajewski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Hayashi for outputting during a telephonic communication in order to evaluate images for composing the image (col. 11, lines 8-21).

As for **claim 13**, Hayashi discloses an apparatus, an image signal receiving apparatus, in fig. 1, comprising:

an image signal processor (ref. 30) for processing a main (original) image signal (col. 3, line 62 – col. 4, line 10);

a display unit (ref. 34) for displaying the received main image signal (col. 3, line 62 – col. 4, line 10);

a controller (ref. 42) for checking whether a cut-off mode has been set for the main image signal (col. 3, line 62 – col. 4, line 29); and

Hayashi teaches a reproducing mode involving a normal reproducing mode and a continuous reproduction mode. The original (main) image is displayed when the forward

(or the reverse) feed button is depressed. A cut off mode is set for the main image signal when the operator depresses the feed button 2 or more seconds. A 4-bit micro-computer determines whether this cut off mode has been set. Also, please read col. 4, line 56 – col. 5, line 9.

an image signal selector (ref. 48) for outputting a sub-image signal instead of the main image signal to the display unit in case that the cut-off mode has been set (col. 4, lines 16-29).

Hayashi also teaches that the image signal is also transmitted to an output terminal (fig. 1, ref. 36). However, Hayashi does not expressly teach an image signal selector for outputting during a telephonic communication. In the same field of endeavor, Szajewski teaches outputting, during a telephonic communication (fig. 1, ref. 46), a sub-image signal. In light of the teaching of Szajewski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Hayashi for outputting during a telephonic communication in order to evaluate images for composing the image (col. 11, lines 8-21).

For **claim 16**, Hayashi, as modified by Szajewski, discloses a method further comprising setting the cut off mode (Hayashi, col. 3, line 62 – col. 4, line 29).

Hayashi teaches a reproducing mode involving a normal reproducing mode and a continuous reproduction mode. The original (main) image is displayed when the forward (or the reverse) feed button is depressed. A cut off mode is set for the main image signal when the operator depresses the feed button 2 or more seconds. A 4-bit micro-computer determines whether this cut off mode has been set. Also, please read Hayashi, col. 4, line 56 – col. 5, line 9.

For **claim 17**, Hayashi, as modified by Szajewski, discloses a method wherein the cut-off mode is set (Hayashi, col. 3, line 62 – col. 4, line 29 and col. 4, line 56 – col. 5, line 9).

However, Hayashi (and Szajewski) do not expressly disclose a method wherein the cut-off mode is set during telephonic communication. The Examiner takes Official Notice that it is well known in the art to set the cut-off mode during telephonic communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a method for setting the cut-off mode during telephonic communication in the imaging devices of Hayashi as well as Szajewski so that a user can not only communicate in an ordinary manner, but also may view a displayed image. This modification would also provide the compressed transmitted images with a constant data rate. It is noted by the Examiner that because Applicant failed to timely traverse the old and well-known statement, it is now taken as Admitted Prior Art (see MPEP 2144.03(c)).

Regarding **claims 18 and 20**, these claims are apparatus claims corresponding to the method claim 16. Therefore, claims 18 and 20 are analyzed and rejected as previously discussed with respect to claim 16.

Regarding **claim 19**, this claim is an apparatus claim corresponding to the method claim 17. Therefore, claim 19 is analyzed and rejected as previously discussed with respect to claim 17.

For **claim 21**, Hayashi, as modified by Szajewski, discloses a method wherein the sub-image signal is a signal stored in a predetermined storing area (images files; Hayashi, col. 4, lines 16-29).

For **claim 22**, Hayashi, as modified by Szajewski, discloses a method wherein the sub-image signal comprises one of a signal inputted by a user (Hayashi, col. 4, lines 16-29) or\* *a previously transmitted main image signal*.

For **claim 23**, Hayashi, as modified by Szajewski, discloses a method transmitting and displaying, during a telephonic communication, the main image signal instead of the sub-image signal in case that the cut-off mode is not set (Hayashi, col. 4, lines 30-40; Szajewski, col. 10, lines 6-44).

For **claim 24**, Hayashi, as modified by Szajewski, discloses a method wherein the sub-image signal comprises one of a signal stored by a user (in Hayashi, see fig. 2 and read col. 2, line 66 – col. 3, line 49) or\* *a previously transmitted main image signal*. This is inherent because with the actuation of the shutter by the operator of the digital camera, the thumbnail is consequently stored on the memory card.

For **claim 25**, Hayashi, as modified by Szajewski, discloses the apparatus wherein the image signal selector outputs the main image to the image signal processor instead of the sub-image signal in case that the cut-off mode is not set (Hayashi, col. 3, line 62 – col. 4, line 40).

Regarding **claims 26 and 28**, these claims are apparatus claims corresponding to the method claim 24. Therefore, claims 26 and 28 are analyzed and rejected as previously discussed with respect to claim 24.

Regarding **claims 27 and 29**, these claims are apparatus claims corresponding to the method claims 25 and 23, respectively. Therefore, claims 27 and 29 are analyzed and rejected as previously discussed with respect to claims 25 and 23, respectively.

For **claim 30**, Hayashi teaches a method (figs. 1, 3-6) for selectively transmitting an image signal (thumbnail) comprising:

inputting an image signal to an image input unit (col. 2, line 66 – col. 3, line 17);

encoding the image signal inputted (col. 3, lines 18-34);

determining if a cut-off mode has been set (Hayashi, col. 3, line 62 – col. 4, line 29 and col. 4, line 56 – col. 5, line 9); and

Hayashi teaches a reproducing mode involving a normal reproducing mode and a continuous reproduction mode. The original image is displayed when the forward (or the reverse) feed button is depressed. A cut off mode is set for the original image signal when the operator depresses the feed button 2 or more seconds. A 4-bit micro-computer determines whether this cut off mode has been set. Also, please read col. 4, line 56 – col. 5, line 9.

transmitting a second (original) image signal stored in a storage unit if the cut-off mode has not been set (col. 3, line 62 – col. 4, line 40) or\* *transmitting the encoded image signal inputted if the cut-off mode has been set.*

Hayashi also teaches that the image signal is also transmitted to an output terminal (fig. 1, ref. 36). However, Hayashi does not expressly teach performing during telephonic communication one of transmitting a second image signal. In the same field of endeavor, Szajewski teaches performing during telephonic communication one of transmitting a second image signal (col. 10, lines 6-44). In light of the teaching of Szajewski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image

device of Hayashi for performing during telephonic communication one of transmitting a second image signal in order to evaluate images for composing the image (col. 11, lines 8-21).

**\*Note:** The U.S. Patent and Trademark Office considers Applicant's "or" language to be anticipated by any reference containing one of the subsequent corresponding elements. Accordingly, Examiner has not considered the limitations, which appear in *italicized font* above.


### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carramah J. Quiett whose telephone number is (571) 272-7316. The examiner can normally be reached on 8:00-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CJQ  
July 9, 2006

  
NGOC-YEN VU  
SUPERVISORY PATENT EXAMINER